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39. (Newly Added) The method of claim 38, further comprising:

2

removing the plug; and

3

removing the source from the aperture.

REMARKS

This is a full and timely response to the non-final Office Action (Paper No. 3) mailed by the U.S. Patent and Trademark Office on July 8, 2002. Claims 1-39 remain pending in the present application. Claims 1, 12, 14, 16-21, and 23 have been amended. Claims 26-39 have been newly added. Applicant submits that the claim amendments add no new matter to the present application. Applicant requests entry of the amendments. In view of the foregoing amendments and the following remarks, reconsideration and allowance of the present application and claims are respectfully requested.

Claim Rejections Under 35 U.S.C. § 112

Claims 12, 14, and 23 presently stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Concerning claim 12, the Office Action alleges: "The limitation 'the platen' in Claim 12 lacks antecedent basis."

Regarding claim 14, the Office Action states: "it is unclear which end of the channel is the 'proximal end,' as a proximal end is not defined in a parent claim. The definition of 'proximal end' should be included in the claim."

Concerning claim 23, the Office Action alleges: "the meaning of 'enabling the optical scanner' is unclear. If the term implies the use of optical elements towards the scanning process within the scanner, the claim should be modified to reflect the intention."

Regarding claim 12, Applicant has amended claim 12 such that the claim recites "a platen." Consequently, claim 12 no longer requires antecedent basis for "the platen."

Concerning claim 14, Applicant has amended dependent claim 14 such that it defines a first end of the channel proximal to a front panel of the housing. Consequently, claim 14 defines "a first end" of the channel.

Regarding claim 23, Applicant has added the phrase "to scan the source," to the originally claimed, "enabling the optical scanner." Therefore, claim 23 clearly describes "enabling the optical scanner."

Accordingly, dependent claims 12, 14, and 23 are in compliance with 35 U.S.C. §112, second paragraph, and are in condition for allowance. Consequently, the rejection of claims 12, 14, and 23 should be withdrawn.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 8-11, 13, 16-18, and 20 presently stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,233,064 to *Griffin*.

Applicant respectfully traverses the rejection of these claims.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See *e.g.*, *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

Claim 1

Claim 1, as amended, recites the following:

1. A space-saving scanner assembly, comprising:
a housing having a substantially vertical source-contact surface with a channel extending from the housing;
and
a flap coupled to the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein ***the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned.***

(Emphasis Added.)

Griffin is apparently directed to a self-supporting cabinet for housing a two-dimensional reader means having a transparent vertically-oriented window. A document support ledge is horizontally placed parallel to the lower external edge of the window. The document support ledge keeps a document, with an image to be scanned, from falling down. A magnet on the top of the cover can be used to keep the cover from falling down. In addition, a second set of feet are added to the cabinet housing to support the scanner from its new bottom. (*Griffin* - Summary of the Invention, column 2, lines 23-32).

The Office Action rejection misinterprets what is disclosed in *Griffin*. Specifically, the Office Action rejection refers to Fig. 1 in support of the assertion that *Griffin* teaches a channel extending from a housing. More specifically, the Office Action alleges that document support ledge (16) of *Griffin* teaches a channel.

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the features of pending claim 1 highlighted above. Consequently, claim 1 is allowable.

More specifically, Applicant respectfully disagrees with the Office Action assertion that *Griffin* teaches a housing with a channel extending there from. Applicant submits that the claimed "***housing having a substantially vertical source-contact surface with a channel extending from the housing***" is not shown in *Griffin*. Fig. 1 of *Griffin* clearly illustrates, and

the detailed description apparently describes, a document support ledge (16) as a flat projecting edge or molding intended to check movement of a document such that it does not fall off the window. A ledge as defined by Merriam-Webster's online collegiate dictionary (<http://www.m-w.com/cgi-bin/dictionary>) is a raised or projecting edge or molding intended to protect or check.

Griffin apparently teaches five embodiments of a document support ledge (16, 116, 216, 316, and 416 in Figs. 1, 5-10, 14, and 17). Each of the five embodiments of the document support ledge (16, 116, 216, 316, and 416) show a raised or projecting edge or molding intended to check movement of a document such that it does not fall off the window. Significantly, each of the embodiments, including the preferred embodiment, do not show "***a channel extending from the housing***" as recited in Applicant's claim 1.

A ledge is not a channel. The document support ledge (16) illustrated in Fig. 1 has a flat surface for checking movement of a document to be scanned. A channel as defined by Merriam-Webster's online collegiate dictionary (<http://www.m-w.com/cgi-bin/dictionary>) is an elongated gutter, groove, or furrow. A ledge, as taught by *Griffin*, does not disclose, teach, or suggest, "***a channel***" as recited in claim 1. Consequently, *Griffin* fails to disclose, teach, or suggest at least this limitation of the claimed invention.

Moreover, because *Griffin* does not disclose, teach, or suggest, "***a channel***" *Griffin* cannot disclose, teach, or suggest, "***the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned.***"

Because *Griffin* does not disclose, teach, or suggest at least the emphasized features of claim 1 as shown above, Applicant respectfully submits that *Griffin* fails to anticipate the presently claimed invention. Consequently, independent claim 1 is allowable and the rejection of claim 1 should be withdrawn.

Claims 2, 8-11, 13

Because independent claim 1 is allowable, its respective dependent claims 2, 8-11, and 13 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or steps of independent claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for the allowability of independent claim 1 and its respective dependent claims, dependent claims 2, 8-11, and 13 recite further features and/or combinations of features, apparent by examination of the claims, that are patentably distinct from the prior art of record. Consequently, there are additional reasons why these dependent claims are separately allowable. Accordingly, Applicant submits that the rejection of claims 2, 8-11, and 13 should be withdrawn.

Claim 16

Independent apparatus claim 16, as amended, recites the following:

16. A space-saving scanner assembly, comprising:
means for optically scanning image data; and
means for forming an aperture configured to closely receive a leading edge of the source, such that the source document can be spatially arranged with the means for optically scanning without adjusting the aperture, the source being supported along a second edge of said source and positioned in alignment with the means for optically scanning during a scanning operation.

(Emphasis Added.)

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the feature of pending claim 16 highlighted above. Consequently, claim 16 is allowable.

Applicant respectfully disagrees with the Office Action assertion that *Griffin* teaches the claimed invention. Applicant submits that the claimed feature, ***“means for forming an aperture configured to closely receive a leading edge of the source, such that the source***

document can be spatially arranged with the means for optically scanning without adjusting the aperture . . .” is not shown in *Griffin*. The Office Action cites housing (10), flap (20), and channel (16) of Fig. 4 as teaching means for spatially adjusting a source to be scanned. Fig. 1 and the cited elements of *Griffin* apparently disclose a way for supporting a document to be scanned over an inclined transparent window. Supporting a document over an inclined transparent window, as apparently taught by *Griffin*, does not disclose, teach, or suggest, “*means for forming an aperture configured to closely receive a leading edge of the source, such that the source document can be spatially arranged with the means for optically scanning without adjusting the aperture . . .*” as recited in claim 16. Consequently, the cited portion *Griffin* fails to disclose, teach, or suggest at least this limitation of the claimed invention.

As apparently described in *Griffin*, a drop-on cover (20) can be set on the support ledge (16) (Fig. 4) after a document or other source is placed on the scanning reader means. The cover is rigid so it will lie close against the vertically oriented angled face to exclude stray light from the two-dimensional scanning reader means. (*Griffin*, column 4, lines 6-11) Other cover embodiments apparently disclosed in *Griffin* include hinged cover 320 and cover 420 (See Figs. 10 and 17, respectively.) Each of the flap embodiments, including the preferred embodiment, do not show an aperture that can receive a source to be scanned without adjusting the aperture.

As apparently described in *Griffin*, the drop-on cover (20), the hinged cover (320) and cover (420) are arranged to closely rest against the vertically oriented inclined face to exclude stray light from the two-dimensional scanning reader means. (*Griffin*, column 4, lines 6-11 and Figs. 10 and 17) None of the three covers (20, 320, and 420), when positioned to permit the scanning means to scan the source, can receive an edge of a source to be scanned. Laying or otherwise positioning a flap or cover on the vertically inclined transparent window after a

document or other source is positioned over the scanning reader means, as apparently taught in *Griffin*, does not disclose, teach, or suggest, “*means for forming an aperture configured to closely receive a leading edge of the source, such that the source document can be spatially arranged with the means for optically scanning without adjusting the aperture . . .*”

Consequently, *Griffin* fails to disclose, teach, or suggest at least this limitation of the claimed invention.

Because *Griffin* does not disclose, teach, or suggest at least the emphasized feature of claim 16 as shown above, Applicant respectfully submits that *Griffin* fails to anticipate the presently claimed invention. Consequently, independent claim 16 is allowable and the rejection of claim 16 should be withdrawn.

Claims 17 and 18

Because independent claim 16 is allowable its respective dependent claims 17 and 18 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or steps of independent claim 16. *In re Fine, supra*. Accordingly, Applicant submits that the rejection of claims 17 and 18 should also be withdrawn.

Claim 20

Independent method claim 20, as amended, recites the following:

20. A method for saving space on a desktop, comprising:
providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface *with a channel extending from the housing*, the vertical source-contact surface including a transparent platen portion, the channel adjacent to a lower edge of the transparent platen; and
providing a flap coupled to the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein *the source-contact surface, the source-backing surface, and the channel*

form an opening for receiving an edge of a source to be scanned.

(Emphasis Added).

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the features of pending claim 20 highlighted above. Consequently, claim 20 is allowable.

Applicant respectfully disagrees with the Office Action assertion that *Griffin* discloses the claimed invention. Applicant submits the claimed ***“providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface with a channel extending from the housing,”*** is not shown in *Griffin*. As argued above with respect to independent claim 1, *Griffin* apparently describes a document support ledge (16). A ledge does not teach a channel. Therefore, a ledge, as apparently taught by *Griffin*, does not disclose, teach, or suggest, ***“providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface with a channel extending from the housing,”*** as recited in claim 20. Consequently, *Griffin* fails to disclose, teach, or suggest at least this limitation of the claimed invention.

Furthermore, Applicant submits the claimed ***“providing a flap coupled to the source-contact surface, . . . , wherein the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned”*** is not shown in *Griffin*. In this regard, the Office Action alleges that Fig. 4 teaches a flap coupled to the source-contact surface. As argued above with respect to independent claim 1, Fig. 4 and the associated detailed description of *Griffin* apparently describe a flap that is placed by an operator onto the document support ledge to cover the backside of the source and the scanning means to exclude stray light. Because *Griffin* does not disclose teach or suggest ***“a channel,”*** *Griffin* cannot form the claimed ***“aperture for receiving an edge of a source to be scanned”*** as recited

in claim 20. Thus, *Griffin* fails to disclose a configuration that forms an aperture with a channel. Consequently, *Griffin* fails to disclose, teach, or suggest at least this limitation of the claimed invention.

Because *Griffin* does not disclose, teach, or suggest at least the emphasized features of claim 20 as shown above, Applicant respectfully submits that *Griffin* fails to anticipate the presently claimed invention. Therefore, independent claim 20 is allowable and the rejection of claim 20 should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 7, 14, and 19

Claims 7, 14, and 19 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Griffin*.

Applicant respectfully traverses the rejection of claims 7, 14, and 19.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 7 and 14

Concerning the Office Action's interpretation of *Griffin*, Applicant has shown above, with regard to the response of the rejection of claims 1, 2, 8-11, and 13 under 35 U.S.C. § 102(e) that *Griffin* does not disclose, teach, or suggest, "*a housing having a substantially vertical source-contact surface with a channel extending from the housing;*" Furthermore, Applicant has also shown that *Griffin* does not disclose, teach, or suggest "*a flap coupled to*

the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, *wherein the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned*” as recited in claim 1.

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the features of pending independent claim 1 highlighted above. Dependent claim 7 depends directly from claim 1. Claim 14 also depends directly from claim 1. Consequently, both claims 7 and 14 include all the limitations of independent claim 1 from which they depend. See *In re Fine, supra*. Therefore, claims 7 and 14 are allowable. Accordingly, for at least these reasons, the rejection of claims 7 and 14 should be withdrawn.

Claim 19

Concerning the Office Action’s interpretation of *Griffin*, Applicant has shown above, with regard to the response of the rejection of claim 16 under 35 U.S.C. § 102(e) that *Griffin* does not disclose, teach, or suggest, “*means for forming an aperture configured to closely receive a leading edge of the source, such that the source document can be spatially arranged with the means for optically scanning without adjusting the aperture . . .*”

Dependent claim 19 includes all the limitations of independent claim 16 from which it depends. See *In re Fine, supra*. Consequently, claim 19 is allowable. Accordingly, for at least these reasons, the rejection of claim 19 should be withdrawn.

Claims 3-6, 12, 15, and 21-25

Claims 3-6, 12, 15, and 21-25 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Griffin* in view of U.S. Patent No. 6,331,886 to *Nagano et al.*

Applicant respectfully traverses the rejection of claims 3-6, 12, 15, and 21-25.

In order for a claim to be properly rejected under 35 U.S.C. § 103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Nagano et al. is apparently directed to an image reading apparatus constructed so that a film holder and an adapter can be selectively mounted to a film scanner that serves as an original placing board. A cartridge containing a dedicated film can be inserted into and removed from the adapter. Image information is read from the film in the film holder or the film in the cartridge by moving the original placing board. Further, the film or the cartridge can be exchanged in a condition where the film holder or the adapter is mounted to the film scanner. (*Nagano et al.* – Abstract)

In contrast with the presently claimed invention, the apparatus apparently disclosed in *Nagano et al.* is directed to a film reader that arranges the film to be read using a cartridge or a film holder. The film reader apparently disclosed in *Nagano et al.* comprises a mounting portion for mounting the holder, which holds a film original. The film original is able to be loaded and/or unloaded from the holder in a condition where the holder is mounted to the mounting portion. In a second embodiment, the reader comprises a loading slot for inserting a film original and transport means for transporting the film original for reciprocating motion from the loading slot toward an inner side of the image reading apparatus. (*Nagano et al.*, column 2, lines 27-45)

The Office Action rejection of claims 3-6, 12, 15, and 21-25 misinterprets what is apparently disclosed in *Griffin* and overlooks at least one significant difference between the *Griffin* apparatus and the claimed space-saving optical scanner. In an attempt to overcome further failures of *Griffin* to teach the claimed invention, the Office Action rejection alleges that

one skilled in the art would be motivated to combine select features allegedly taught in *Nagano et al.* to the scanner of *Griffin* to reach the claimed device.

Concerning the Office Action's interpretation of *Griffin*, Applicant has shown above, with regard to the response of the rejection of claims 1, 2, 8-11, and 13 under 35 U.S.C. § 102(e) that *Griffin* does not disclose, teach, or suggest, "***a housing having a substantially vertical source-contact surface with a channel extending from the housing;***" Furthermore, Applicant has also shown that *Griffin* does not disclose, teach, or suggest "***a flap coupled to the source-contact surface***, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, ***wherein the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned***" as recited in claim 1.

Applicant respectfully submits that even the proposed combination fails to disclose, teach, or suggest at least the features of pending dependent claims 3 and 4 highlighted above. "Dependent claims are non-obvious under section 103 if the independent claims from which they depend are non-obvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Dependent claims 3-6, 12, and 15 include all the limitations of independent claim 1 from which they directly and indirectly depend.

The Office Action rejection alleges that Fig. 13 of *Nagano et al.* teaches an inclined surface adjacent to the opening. Inspection of Fig. 13 reveals that the front panel of *Nagano et al.* includes a concave recess adjacent the opening that receives the film cartridge and/or the film adapter. A concave recess is not an inclined surface. Consequently, *Nagano et al.* fails to remedy the failure of *Griffin* to teach the claimed apparatus.

In addition, even if *Nagano et al.* teaches all that the Office Action alleges, *Nagano et al.* does not remedy at least the highlighted failures of *Griffin* to teach the claimed space-saving scanner. Therefore, for at least these reasons, Applicant respectfully submits that

claims 3 and 4 are patentable over the proposed combination. Accordingly, for at least these reasons, the rejection of claims 3 and 4 should be withdrawn.

Furthermore, Applicant respectfully submits that even the proposed combination fails to disclose, teach, or suggest at least the features of pending dependent claims 5 and 12 highlighted above. In this regard, the Office Action rejection alleges that Fig. 1 of *Nagano et al.* teaches a flap (1) containing a slot (between 1a and 1b) in which to insert and secure a relatively short source document such as a slide or a strip of film. Applicant disagrees with this interpretation of *Nagano et al.* Inspection of Fig. 1 and the associated detailed description (column 4, lines 16-37) reveals a film carriage (1) with mounting portions (1a and 1b). A film carriage and mounting portions do not teach a flap containing a slot. Consequently, *Nagano et al.* fails to remedy the failure of *Griffin* to teach the claimed apparatus.

In addition, even if *Nagano et al.* teaches all that the Office Action alleges, *Nagano et al.* does not remedy at least the highlighted failures of *Griffin* to teach the claimed space-saving scanner. Therefore, for at least these reasons, Applicant respectfully submits that claims 5 and 12 are patentable over the proposed combination. Accordingly, for at least these reasons, the rejection of claims 5 and 12 should be withdrawn.

Moreover, Applicant respectfully submits that even the proposed combination fails to disclose, teach, or suggest at least the features of pending dependent claim 6 highlighted above. In this regard, the Office Action rejection alleges that Fig. 1 of *Nagano et al.* teaches a flap (1) containing a clip (1a) to receive a portion of a source to be scanned. Applicant disagrees with this interpretation of *Nagano et al.* Inspection of Fig. 1 and the associated detailed description (column 4, lines 16-37) reveals a film carriage (1) with mounting portions (1a and 1b). A film carriage and mounting portions do not teach a flap containing a

clip. Consequently, *Nagano et al.* fails to remedy the failure of *Griffin* to teach the claimed apparatus.

In addition, even if *Nagano et al.* teaches all that the Office Action alleges, *Nagano et al.* does not remedy at least the highlighted failures of *Griffin* to teach the claimed space-saving scanner. Therefore, for at least these reasons, Applicant respectfully submits that claim 6 is patentable over the proposed combination. Accordingly, for at least these reasons, the rejection of claim 6 should be withdrawn.

Similarly, Applicant respectfully submits that even the proposed combination fails to disclose, teach, or suggest at least the features of pending dependent claim 15 highlighted above. In this regard, the Office Action rejection admits that neither *Griffin* nor *Nagano et al.* teaches a channel coated with a material having a relatively low coefficient of friction. In order to overcome these failures, the Office Action rejection alleges, despite any mention of the composition of the scanner apparently disclosed in *Griffin*; or the film reader apparently disclosed in *Nagano et al.*, "it is inherent that a plastic compound is used to mold the front panel and the channel." No such limitation is claimed nor suggested anywhere in the cited art. Despite these failures of the cited art to teach the claimed invention, the Office Action rejection concludes that it would have been obvious to coat the channel of *Griffin* with a material having a relatively low coefficient of friction. Applicant disagrees. As argued above, *Griffin* apparently teaches a document support ledge (16) not a channel. Consequently, even if one skilled in the art would be inclined to coat the document support ledge of *Griffin* with a material having a relatively low coefficient of friction, the combination of the proposed teachings would still not result in the presently claimed apparatus. Consequently, even the proposed combination fails to disclose, teach, or suggest the claimed apparatus.

Consequently, for at least these reasons, Applicant respectfully submits that claim 15 is patentable over the proposed combination. Accordingly, for at least these reasons, the rejection of claim 15 should be withdrawn.

Accordingly, for at least these reasons, the rejection of claims 3-6, 12, and 15 should be withdrawn.

Furthermore, Applicant respectfully submits that even the proposed combination fails to disclose, teach, or suggest at least the features of pending dependent claims 21-25 highlighted above in independent claim 20. In this regard, the Office Action rejection alleges that Fig. 1 of *Nagano et al.* teaches the insertion of a leading edge of a source (7) into an opening formed by a flap (1) a channel (1a), and a clip (1b) in which to insert and secure a relatively short source document such as a slide or a strip of film. Applicant disagrees with this interpretation of *Nagano et al.* Inspection of Fig. 1 and the associated detailed description (column 4, lines 16-37) reveals a film reader for reading a film source that uses a film carriage (1) with mounting portions (1a and 1b). A film carriage and mounting portions do not teach, "*providing a flap coupled to the source-contact surface, . . . wherein the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned.*" as recited in independent claim 20. Consequently, *Nagano et al.* fails to remedy the failure of *Griffin* to teach the claimed apparatus.

In addition, even if *Nagano et al.* teaches all that the Office Action alleges, *Nagano et al.* does not remedy at least the highlighted failures of *Griffin* to teach the claimed method for saving space on a desktop. Therefore, for at least these reasons, Applicant respectfully submits that claims 21-25 are patentable over the proposed combination. Accordingly, for at least these reasons, the rejection of claims 21-25 should be withdrawn.

Applicant respectfully submits that the Office Action rejection has failed to establish a *prima facie* case of obviousness. Regarding the Office Actions failure to establish a *prima facie* case of obviousness, “[t]he PTO has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

As described above, *Griffin* does not disclose, teach, or suggest, “***a housing having a substantially vertical source-contact surface with a channel extending from the housing;***” Furthermore, *Griffin* does not disclose, teach, or suggest “***a flap coupled to the source-contact surface***, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, ***wherein the source-contact surface, the source-backing surface, and the channel form an aperture for receiving an edge of a source to be scanned***” as recited in claim 1.

The Office Action rejection fails to meet the burden under 35 U.S.C. § 103(a) of citing a prior art reference (or references when combined) that teaches or suggests all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art and not based on the Applicant’s disclosure. In contrast with the presently claimed invention, the apparatus, apparently disclosed in *Griffin* describes an inclined housing with a document support ledge and a flap that rests over a document that has been placed over a transparent window. Also in contrast with the presently claimed invention, *Nagano et al.*, includes a film reader that uses a cartridge and/or an adapter to arrange a film source with the film reader.

Consequently, in order to establish a *prima facie* case of obviousness, the Office Action must cite an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the inclined housing of

Griffin with the film reader of *Nagano et al.*, to reach the claimed invention. Applicant respectfully submits that one skilled in the art would not be motivated to save desktop space by combining the teachings of *Griffin* and *Nagano et al.* for at least the reason that the cited references deal with entirely different source materials. *Griffin* apparently teaches a document and book scanner, whereas, *Nagano et al.* apparently disclose a film reader.

Applicant submits that one skilled in the art when trying to minimize desktop space used by a scanner would not be inclined to combine the features apparently disclosed in *Griffin* with the features apparently disclosed in *Nagano et al.* to reach the claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness and is improper. Accordingly, for at least this additional reason, the rejection of claims 3-6, 12, 15, and 21-25 should be withdrawn.


In summary, Applicant respectfully submits that a *prima facie* case for obviousness has not been made against Applicant's dependent claims 3-6, 12, 15, and 21-25. Therefore, it is respectfully submitted that each of the pending claims 3-6, 12, 15, and 21-25 is allowable over the cited prior art and that the rejection of these claims should be withdrawn.

CONCLUSION

Claims 1-39 remain pending in the present application. Claims 1, 12, 14, 16-21, and 23 have been amended. Claims 26-29 have been added. For at least the foregoing reasons, Applicant respectfully requests that the outstanding rejection of claims 1-25 be withdrawn and that pending claims 1-39 of this application be allowed to issue. If the Examiner has any comments regarding Applicant's response or intends to dispose of this matter in a manner other than a notice of allowance, Applicant requests that the Examiner telephone Applicant's undersigned attorney.

Respectfully submitted,

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APPENDIX-CLAIM AMENDMENTS

Pursuant to 37 C.F.R. §1.121(c)(1)(ii), the following amended claims are included below. Changes are indicated by deleting that language which is enclosed within brackets (“[]”) and by inserting that language which is underlined (“ ”).

- 1 1. A space-saving scanner assembly, comprising:
2 a housing having a substantially vertical source-contact surface with a channel
3 extending from the housing [therefrom]; and
4 a flap coupled to the source-contact surface, the flap having a source-backing
5 surface substantially parallel to the source-contact surface of the housing, wherein the
6 source-contact surface, the source-backing surface, and the channel form an aperture
7 [opening] for receiving an edge of a source to be scanned.
- 1 12. The assembly of claim 5, wherein the slot is positioned to permit the
2 placement of a relatively short source document on edge on the channel wherein
3 information to be scanned is aligned with at least a portion of a a [the] platen.
- 1 14. The assembly of claim 1, wherein the width of a first end [the proximal
2 end] of the channel proximal to a front panel of the housing increases over that
3 portion of the channel that extends beyond the platen.
- 1 16. A space-saving scanner assembly, comprising:
2 means for optically scanning [and converting] image data [into a digital data
3 representation of a source]; and
4 [means for spatially adjusting a source to be scanned with the means for
5 optical scanning; and]
6 means for forming an aperture configured to closely receive a leading edge of
7 the source, such that the source can be spatially arranged with the means for optically
8 scanning without adjusting the aperture, the source being supported along a second
9 edge of said source as the source is received in the aperture and [means for supporting
10 the source along an edge of said source] during a scanning operation.

1 17. The assembly of claim 16, wherein the means for forming an aperture
2 [source edge support means] comprises a channel.

1 18. The assembly of claim 16, wherein the means for forming an aperture
2 [adjusting means] comprises a flap having a slot.

1 19. The assembly of claim 16, wherein the means for forming an aperture
2 [adjusting means] comprises a first inclined surface associated with a housing and a
3 second inclined surface associated with a flap.

1 20. A method for saving space on a desktop, comprising:
2 providing an optical scanner having a housing, the housing having a
3 substantially vertical source-contact surface with a channel extending from the
4 housing [therefrom], the vertical source-contact surface including a transparent platen
5 portion, the channel adjacent to a lower edge of the transparent platen; and
6 providing a flap coupled to the source-contact surface, the flap having a
7 source-backing surface substantially parallel to the source-contact surface of the
8 housing, wherein the source-contact surface, the source-backing surface, and the
9 channel form an aperture [opening] for receiving an edge of a source to be scanned.

1 21. The method of claim 20, further comprising:
2 inserting a leading edge of a source to be scanned into the aperture [opening]
3 formed by the source-contact surface, the flap, and the channel such that the source is
4 supported along a second edge by the channel.

1 23. The method of claim 22, further comprising:
2 enabling the optical scanner to scan the source.